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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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				VAN DOREN, BETH
			ART UNIT	PAPER NUMBER
				3623

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/683,668	LASKOSKI, SARAH	
	<b>Examiner</b>	<b>Art Unit</b>	
	Beth Van Doren	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 February 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                               |                                                                             |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                          | Paper No(s)/Mail Date. _____.                                               |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20020227</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                                               | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

1. The following is a non-final, first office action on the merits. Claims 1-42 are pending.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitations "the licensee product" and "the licensee customer".

There is insufficient antecedent basis for these limitations in the claim. Appropriate correction is required. For examination purposes, the limitations have been construed as --a licensee product-- and --a the licensee customer--.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2-3, 9-11, 13-18, 26-28, 31, and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029).

As per claim 1, Nutter et al. teaches a tool to prioritize opportunities by assigning a relative calculated value to every opportunity, the tool comprising:

at least one module having a plurality of value drivers (See figure 7, paragraphs 0025, 0029, 0039, which discusses the system storing parameters that drive value);  
a plurality of user-specified variables in response to the value drivers (See paragraphs 0019, 0022, 0025-6, 0039, which discloses a user inputting variables into the system in response to the parameters);  
a database coupled to the tool that stores data concerning the evaluation (See figures 1 and 2, paragraphs 0021, 0046); and  
a processor operative to calculate an opportunity value for each entered opportunity by a pre-determined function using said user-specified variables and to prioritize the calculated opportunity values (See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, Nutter et al. does not expressly disclose storing the calculated opportunity values for each entered opportunity.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the calculated opportunity values (which are manipulated by the computer of Nutter et al.) in the database of the system in order to more easily eliminate intellectual

properties from licensing choices by use of the computer. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

As per claim 2, Nutter et al. discloses wherein pre-determined weighting factors are applied to each of the plurality of value drivers (See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers).

As per claim 3, Nutter et al. teaches wherein the at least one module comprises a market module having a plurality of value drivers relating to the marketability of the entered opportunity (See figure 7, paragraphs 0028-32 and 0034, wherein the market of the opportunity is considered in the evaluation).

As per claim 9, Nutter et al. teaches wherein the at least one module comprises an efficiency module having a plurality of value drivers relating to efficiency of the entered opportunity (See figure 7, 13, paragraphs 0025, 0030, 0034, which at least discloses ease of investigation, strength of claims, all of which are directed towards the effectiveness of the opportunity).

As per claim 10, Nutter et al. discloses calculating an opportunity value for each opportunity using a pre-determined function using variables related to various factors (See paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, while Nutter et al. teaches a plurality of licensing and market factors, Nutter et al. does not expressly disclose factors relating to value drivers relating to the efficiency of employee job, job knowledge, job tasks, and employee-customer relations for the entered opportunity.

Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. It is well known in the art that when a new product or opportunity is introduced to an organization that employee job, job knowledge, job tasks, and employee-customer relations must be considered to ensure that the organization is capable of handling the new product/opportunity. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors of employee job, job knowledge, job tasks, and employee-customer relations with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

As per claim 11, Nutter et al. wherein the at least one module comprises an impact module having a plurality of value drivers relating to overall impact of the entered opportunity on the licensee product and licensee customers (See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license).

As per claim 13, Nutter et al. discloses wherein a form is published on an accessible information network and displays at least one of the plurality of value drivers (See paragraphs 0021, 0039, figures 7, 11, wherein a form is accessible via an information network and displays parameters with which the user is able to interact and enter data).

As per claim 14, Nutter et al. teaches wherein the form is operative to submit the plurality of user-specified variables in response to the value drivers for each of the entered opportunity (See paragraphs 0021-22, 0025-6, 0039, which discloses a user inputting variables into the system in response to the parameters).

However, Nutter et al. does not expressly disclose submitting the variables to a database. Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the variables of Nutter et al. in the database of the system in order to more easily eliminate intellectual properties from licensing choices using the computer and the organization provided by the database. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

As per claim 15, Nutter et al. teaches wherein the system receives the user-specified variables in response to the value drivers and to calculate a module score for at least one module and a total score for each of the entered opportunity (See paragraphs 0019, 0022, 0025-8, 0031, 0039, wherein a score and total score is calculated. See also figure 13).

However, Nutter et al. does not expressly disclose a database is operative to store variables.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the variables of Nutter et al. in the database of the system in order to more

easily eliminate intellectual properties from licensing choices using the computer and the organization provided by the database. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

As per claim 16, Nutter et al. teaches wherein the calculated total score is a pre-determined weighted average of the module scores for each of the entered opportunity (See paragraphs 0025, 0027, 0039, wherein a weighted average is calculated).

As per claim 17, Nutter et al. discloses wherein the calculated module score is a pre-determined weighted average of the user-specified variables within a module for each of the entered opportunity (See paragraphs 0025, 0027, 0039, wherein a weighted average is calculated).

As per claim 18, Nutter et al. discloses notifying a recipient about the entered opportunity and corresponding total and module scores (See figure 13, paragraphs 0021, 0038, 0041-4, wherein the recipient is notified via output of the total and separate scores).

However, Nutter et al. does not expressly disclose a database operative to notify recipients.

Nutter et al. discloses a database coupled to the tool (and processor), calculating an opportunity value for each entered opportunity using a scoring function, and notifying a recipient via output of the total and separate scores. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Further, it is old and well known to store notification templates linked with data in the database. therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the database of Nutter et al. would be operative to notify the recipients in order

to more easily eliminate intellectual properties from licensing choices using the computer and the organization provided by the database. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

Claims 26-28, 31, and 33-38 recite equivalent limitations to claims 1-3, 11, and 13-18, respectively, and are therefore rejected using the same art and rationale relied upon above.

6. Claims 4-8, 19-25, 29-30, 39, and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029) in view of Elliott (U.S. 2001/0042034).

As per claims 4-8, Nutter et al. discloses calculating an opportunity value for each opportunity using a pre-determined function using variables related to various factors (See paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, while Nutter et al. teaches a plurality of licensing and market factors, Nutter et al. does not expressly disclose ownership of the entered opportunity, available resources to be applied to development, development cost, development time, implementation cost, and implementation time, financial needs, implications, and cost feasibility as the specific factors used.

Elliott discloses:

As per claim 4, value drivers relating to ownership of the entered opportunity (See paragraphs 0020-2, which discloses ownership of the licensing opportunity).

As per claim 5, value drivers relating to available resources to be applied to development of the entered opportunity (See paragraphs 0009, 0034, 0111, 0155-6, 0163, which discloses development and the money needed for the development).

As per claim 6, a cost module having a plurality of value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity (See paragraphs 0034-5, 0111, 0117-8, 0121-2, which discloses cost consideration).

As per claim 7, value drivers relating to development cost and development time of the entered opportunity (See paragraphs 0009, 0034, 0111, 0149, 0155-6, 0163, which discloses development, the money needed for the development, and the years of development).

As per claim 8, value drivers relating to implementation cost and implementation time of the entered opportunity (See paragraphs 0111, 0150-2, 0155-6, 0157-9, 0163, which discloses manufacturing, materials, and operation costs, as well as years of sales and years of expenses).

Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Elliott discloses valuation of intellectual property using factors such as ownership of the entered opportunity, available resources to be applied to development, development cost, development time, implementation cost, and implementation time, financial needs, implications, and cost feasibility. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors of ownership of the entered opportunity, available resources to be applied to development, development cost, development time, implementation cost, and implementation time, financial needs, implications, and cost feasibility with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate

intellectual properties that do not score as well as others based on the same evaluation factors.

See paragraph 0019, 0026, of Nutter et al.

As per claim 19, Nutter et al. teaches a system to prioritize licensing opportunities by assigning a relative calculated value to every opportunity, said tool comprising:

a plurality of modules each having a plurality of value drivers (See figure 7, paragraphs 0025, 0029, 0039, which discusses the system storing parameters that drive value), said plurality of modules comprising:

a market module having a plurality of value drivers relating to the marketability of the entered opportunity (See figure 7, paragraphs 0028-32 and 0034, wherein the market of the opportunity is considered in the evaluation);

an efficiency module having a plurality of value drivers relating to efficiency of the entered opportunity (See figure 7, 13, paragraphs 0025, 0030, 0034, which at least discloses ease of investigation, strength of claims, all of which are directed towards the effectiveness of the opportunity); and

an impact module having a plurality of value drivers relating to overall impact of the entered opportunity on the licensee product and licensee customers (See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license);

a plurality of user-specified variables, linked to pre-determined weighting factors, in response to the value drivers (See paragraphs 0019, 0022, 0025-6, 0039, which discloses a user inputting variables into the system in response to the parameters. See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers);

a database coupled to the tool that stores data concerning the evaluation (See figures 1 and 2, paragraphs 0021, 0046); and

a processor operative to calculate an opportunity value for each entered opportunity by a pre-determined function using the user-specified variables and prioritizing the calculated opportunity values (See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, Nutter et al. does not expressly disclose storing the calculated opportunity values for each entered opportunity. Nutter et al. further does not expressly disclose that the plurality of modules includes a cost module having a plurality of value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity.

Elliott discloses value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity (See paragraphs 0034-5, 0111, 0117-8, 0121-2, which discloses cost consideration).

However Elliott does not expressly disclose storing the calculated opportunity values for each entered opportunity.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the calculated opportunity values (which are manipulated by the computer of

Nutter et al.) in the database of the system in order to more easily eliminate intellectual properties from licensing choices by use of the computer. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities.

Further, Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Elliott discloses valuation of intellectual property using factors such as financial needs, implications, and cost feasibility. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors financial needs, implications, and cost feasibility with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

Claim 20 recites equivalent limitations to the combination of claims 4 and 5 and is rejected using the same art and rationale relied upon above.

Claim 21 recites equivalent limitations to the combination of claims 7 and 8 and is rejected using the same art and rationale relied upon above.

Claims 22 and 23 recite equivalent limitations to claims 10 and 12, respectively, and are therefore rejected using the same art and rational set forth above.

Claim 24 recites equivalent limitations to the combination of claims 13 and 14 and is rejected using the same art and rationale relied upon above.

Claim 25 recites equivalent limitations to the combination of claims 14, 17, and 18 and is rejected using the same art and rationale relied upon above.

Claims 29 and 30 recite equivalent limitations to claims 6 and 9, respectively, and are therefore rejected using the same art and rational set forth above.

As per claim 39, Nutter et al. discloses a method to prioritize licensing opportunities by assigning a relative calculated value to every opportunity, the method comprising the steps of:

providing a plurality of modules each having a plurality of value drivers (See figure 7, paragraphs 0025, 0029, 0039, which discusses the system storing parameters that drive value), said plurality of modules comprising:

a market module having a plurality of value drivers relating to the marketability of the entered opportunity (See figure 7, paragraphs 0028-32 and 0034, wherein the market of the opportunity is considered in the evaluation);

an efficiency module having a plurality of value drivers relating to efficiency of the entered opportunity (See figure 7, 13, paragraphs 0025, 0030, 0034, which at least discloses ease of investigation, strength of claims, all of which are directed towards the effectiveness of the opportunity);

an impact module having a plurality of value drivers relating to overall impact of the entered opportunity on the licensee product and licensee customers (See paragraph 0034, which discloses considering the impact of the license on the products of the customer using the license

applying pre-determined weighting factors to each of the plurality of value drivers (See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers);

a published form on an accessible information network that displays at least one of the plurality of value drivers (See paragraphs 0021, 0039, figures 7, 11, wherein a form is accessible

via an information network and displays parameters with which the user is able to interact and enter data);

providing a plurality of user-specified variables, linked to pre-determined weighting factors, in response to the value drivers (See paragraphs 0019, 0022, 0025-6, 0039, which discloses a user inputting variables into the system in response to the parameters. See paragraphs 0025, 0027, 0030, which discloses weighting factors used in the scoring of the value drivers);

calculating a total score and module scores for each entered opportunity by a pre-determined function using the user-specified variables (See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a function is used to calculate a score value based on the input variables);

a database coupled to the tool that stores data concerning the evaluation (See figures 1 and 2, paragraphs 0021, 0046); and

notifying a recipient about the entered opportunity and corresponding total and module scores (See figure 13, paragraphs 0021, 0038, 0041-4, wherein the recipient is notified via output of the total and separate scores); and

prioritizing the calculated opportunity values (See paragraphs 0019, 0021, 0026, 0028, 0030-1, wherein a scores and data are used to rank, sort, and/prioritize).

However, Nutter et al. does not expressly disclose storing the calculated opportunity values for each entered opportunity. Nutter et al. further does not expressly disclose that the plurality of modules includes a cost module having a plurality of value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity.

Elliott discloses value drivers relating to financial needs, implications, and cost feasibility of the entered opportunity (See paragraphs 0034-5, 0111, 0117-8, 0121-2, which discloses cost consideration).

However Elliott does not expressly disclose storing the calculated opportunity values for each entered opportunity.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the calculated opportunity values (which are manipulated by the computer of Nutter et al.) in the database of the system in order to more easily eliminate intellectual properties from licensing choices by use of the computer. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities. Further, Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Elliott discloses valuation of intellectual property using factors such as financial needs, implications, and cost feasibility. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors financial needs, implications, and cost feasibility with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

As per claim 41, Nutter et al. teaches wherein the published form is network enabled form that displays at least one of the plurality of value drivers and is operative to receive the plurality of user-specified variables in response to the value drivers (See paragraphs 0021, 0039, figures 7, 11, wherein a form is accessible via an information network and displays parameters with which the user is able to interact and enter data. See also paragraphs 0025-6. A user inputs variables into the system in response to the parameters).

However, Nutter et al. does not expressly disclose submitting the variables to a database or that the form is web enabled and multi-layered.

Nutter et al. discloses a database coupled to the tool (and processor) that stores data concerning the evaluation as well as calculating an opportunity value for each entered opportunity using a scoring function. Nutter et al. further discloses an automated form that is network enabled and also for the collection of input data. Databases are old and well known in the art for collecting and organizing information so that it can easily be accessed and used, managed, and updated. Also, the web is a well known network in the art allowing for more efficient connections with remote locations. Finally, it is old and well known in the art to use layering in programming for better organization by separating functional components that interact in some sequential and hierarchical way. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to store the variables of Nutter et al. in the database of the system in order to more easily eliminate intellectual properties from licensing choices using the computer and the organization provided by the database. See paragraphs 0019, 0021, which discusses the use of databases and computers to more easily access the opportunities. Further, it would have been obvious to one of ordinary skill in the art at the time

of the invention to use the web and layering in the form of Nutter et al. in order to more efficiently implement the system of Nutter et al. by using well known computing means that allow for better efficiency in communications.

Claim 42 recites equivalent limitations to the combination of claims 14, 17, and 18, and is therefore rejected using the same art and rationale set forth above.

7. Claims 12 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029) in view of Wilkinson et al. (U.S. 2002/0099637).

As per claim 12, Nutter et al. discloses calculating an opportunity value for each opportunity using a pre-determined function using variables related to various factors (See paragraphs 0019, 0021, 0026, 0028, 0030-1, 0034, wherein a function is used to calculate a value based on the input variables by the user and the values are ranked, sorted, and/or prioritized).

However, while Nutter et al. teaches a plurality of licensing and market factors, Nutter et al. does not expressly disclose spin-off ideas, development challenges, and deficiencies as specific factors used.

Wilkinson et al. discloses a plurality of value drivers relating to spin-off ideas, development challenges, and deficiencies of the entered opportunity (See paragraphs 0019-20, 0028-9, 0037, 0054).

Nutter et al. discloses rating a licensing opportunity using a scoring function including factors related to the market and industry in which the opportunity resides. Wilkinson et al. discloses valuation of intellectual property using factors such as spin-off ideas, development challenges, and deficiencies. It would have been obvious to one of ordinary skill in the art at the

time of the invention to include the factors of spin-off ideas, development challenges, and deficiencies with the factors used in the scoring function of Nutter et al. in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors. See paragraph 0019, 0026, of Nutter et al.

Claim 32 recites equivalent limitations to claim 12, and is therefore rejected using the same art and rationale set forth above.

8. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nutter et al. (U.S. 2002/0178029) in view of Elliott (U.S. 2001/0042034) and in further view of Wilkinson et al. (U.S. 2002/0099637).

As per claim 40, neither Elliot or Nutter et al. disclose a plurality of value drivers relating to spin-off ideas, development challenges, and deficiencies of the entered opportunity.

Wilkinson et al. discloses a plurality of value drivers relating to spin-off ideas, development challenges, and deficiencies of the entered opportunity (See paragraphs 0019-20, 0028-9, 0037, 0054).

Nutter et al. and Elliot both disclose valuing an intellectual asset based on various factors, the factors used in scoring the opportunities. Wilkinson et al. also discloses valuation of intellectual property using factors such as spin-off ideas, development challenges, and deficiencies. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the factors of spin-off ideas, development challenges, and deficiencies with the factors used in the scoring function of Nutter et al., along with the other factors

disclosed by Elliot, in order to more efficiently evaluate intellectual properties and eliminate intellectual properties that do not score as well as others based on the same evaluation factors.

See paragraph 0019, 0026, of Nutter et al.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Contractor (U.S. 2004/0158473) discloses calculating a value by evaluating the licensing of a product.

Del Vecchio et al. (U.S. 20030036945) discloses assessing an intellectual property (IP) asset by collecting data concerning the IP and generating a report.

Hagelin (U.S. 2002/0077835) teaches different methods and considerations when valuing intellectual property assets.

Donner (U.S. 6,263,314) teaches evaluating an intellectual property using a network based tool, where an IP worth index is calculated.

Hartung et al. (U.S. 2003/0074291) discloses evaluating a development project based on models and weighting factors.

Barney et al. (U.S. 6,556,992) discloses a system for valuation of patents and other intangible assets based on breadth, commercial relevance, and defensibility.

Wilkinson (U.S. 2001/0034695) teaches valuation of intellectual property assets based on a classification, valuation data, and computing a value for the asset.

Art Unit: 3623

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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bvd*

August 28, 2006

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